

### REMARKS

Claims 1-67 remain for consideration. All claims are thought to be allowable over the cited art.

In Paragraph 4) of the 3/13/2006 Office Action, the Examiner requests Applicants to locate support in the original disclosure for amendments made in the response to the 9/8/2005 Office Action. Applicants submit that the subject matter is supported in numerous places within the original disclosure, such as in paragraphs [0198]-[0201] and FIGs. 32-35, of the original disclosure. Applicants invite the Examiner to verify that proper support for the amendments is found in the original disclosure and, therefore, requests the Examiner to remove the objection to the specification as recited in Paragraph 5) of the 3/13/2006 Office Action.

Applicants acknowledge the withdrawal of the objections pertaining to claims 5-6 and 39-40. However, in Paragraph 4) of the 3/13/2006 Office Action, the Examiner intimates that Applicants have failed to respond to certain objections to the claims as articulated in the 9/8/2005 Office Action. Applicants respectfully submit that a proper response to all objections was proffered in the 12/21/2005 response and that the response was persuasive. In particular, Applicants believe that the duplicate claims warning as to claims 29-32 and 60-63, as articulated in the 9/8/2005 Office Action has been withdrawn in response to Applicant's remarks. Thus, the Applicants advance prosecution of the instant application accordingly.

In Paragraph 3) of the 9/8/2005 Office Action, the Examiner has indicated that Applicants' arguments have been considered, but are moot in view of the new grounds for rejection. In Paragraph 4), however, the Office Action states "[t]he dependent and non-amended claims stand rejected as articulated in the First Office Action and all objections not addressed in Applicant's response are herein reiterated." The Examiner, therefore, provides no reasons as to why the rejections articulated in the 9/8/2005 Office Action were not overcome by Applicant's 12/21/2005 response with respect to non-amended claims: 23, 28, 54, and 59; and associated dependent claims: 24-27, 29-32, 55-58, and 60-63, respectively. The Applicants traversed the

rejections, and provided reasons why the cited references do not teach the subject matter of the claims.

37 C.F.R. §1.104 and M.P.E.P. §707 (particularly M.P.E.P. §707.07 and §707.07(f)) set forth the requirement that the Examiner address all arguments which have not already been responded to in the statement of the rejection, and that when an Applicants traverse any rejection, the Examiner should, if he or she repeats the rejection, take note of the Applicants' argument and answer the substance of it. The Examiner has not addressed Applicants' arguments pertaining to the rejection of non-amended claims: 23, 28, 54, and 59; and associated dependent claims: 24-27, 29-32, 55-58, and 60-63, respectively, and has submitted identical rejections without explanation.

The Applicants believe that the arguments set forth in the 12/21/2005 response overcome the Examiner's arguments alleging the reference's teaching of the subject matter of non-amended claims: 23, 28, 54, and 59; and associated dependent claims: 24-27, 29-32, 55-58, and 60-63, respectively. Therefore, to the extent that the rejections articulated in the 9/8/2005 Office Action are maintained on the grounds of 35 U.S.C. §102(e) and 35 U.S.C. §103(a) as being unpatentable over the cited references, Applicants respectfully request that the Examiner present some indication as to why Applicants' response was deemed unpersuasive. Without this information, the Applicants are deprived of the opportunity to address the PTO's position or otherwise advance the application.

For purposes of the present response, Applicants maintain the allowability arguments submitted in the 12/21/2005 response with regard to non-amended claims: 23, 28, 54, and 59; and associated dependent claims: 24-27, 29-32, 55-58, and 60-63, respectively. Applicants respectfully submit, therefore, that the finality of the rejection with regard to non-amended claims: 23, 28, 54, and 59; and associated dependent claims: 24-27, 29-32, 55-58, and 60-63, respectively, is premature and improper and should be withdrawn. Applicants further respectfully request that a complete response to Applicants' remarks in accordance with M.P.E.P. § 707.07 and § 707.07(f) be submitted with the subsequent Office Action.

The office action fails to establish that claims 1-8, 11-25, 27-30, 32-33, 35-56, 58-61, 62-64, and 66-67 are anticipated under 35 U.S.C. 102(e) by U.S. Patent No. 6,917,594 to Feuerstraeter et al (hereinafter "Feuerstraeter").

In addition to the remarks provided in the 12/21/2005 response, which are incorporated herein by reference, Applicants provide further explanation as to the allowability of claims 1-8, 11-25, 27-30, 32-33, 35-56, 58-61, 62-64, and 66-67. To anticipate a claim, the asserted reference must teach all the limitations of the claimed invention. Feuerstraeter, however, is not shown to teach the use of determined transmission characteristics of a transmission path between a transmitting entity and a target entity in order to select a transmission convention prior to data transmission as is required by Applicant's claim 1.

The Office Action suggests that Feuerstraeter teaches such an operation at column 8, lines 9-16. However, it is noted that Feuerstraeter seems to select a transmission convention after data transmission. Feuerstraeter seems to teach that data must first be transmitted, errors must then be detected, and only then will the transmission protocol be changed if necessary. (See column 8, lines 9-16). Thus, Feuerstraeter apparently does not alter a transmission protocol until after the data is transmitted. Furthermore, Feuerstraeter apparently only alters the transmission protocol after it is determined that errors exist in the data transmission. Thus, Feuerstraeter seems to require that in every case: 1) data must first be transmitted; 2) errors must then be detected; and 3) if the detected error rate is too high, then a new data rate is selected. Accordingly, Feuerstraeter seems to require selection of a transmission convention after data transmission, which is in contradistinction to Applicants' Claim 1.

Applicants' Claims 15, 33, 37, 46, and 64 similarly set forth at least that the use of determined transmission characteristics of a transmission path between a transmitting entity and a target entity is required in order to select a transmission convention prior to data transmission. The Applicants respectfully submit, therefore, that Claims 1, 15, 33, 37, 46, and 64 patentably distinguish over Feuerstraeter and are in condition for allowance.

Dependent Claims 2-8, 11-14, 16-22, 35-36, 38-45, 47-53, and 67, which are dependent from independent Claims 1, 15, 33, 37, 46, and 64, respectively, are also rejected under 35 U.S.C. §102(e) as being unpatentable over Feuerstraeter. While Applicants do not acquiesce to the particular rejections to these dependent claims, it is understood that these rejections are now moot in view of the remarks made in connection with independent Claims 1, 15, 33, 37, 46, and 64. These dependent claims include all of the limitations of the base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 2-8, 11-14, 16-22, 35-36, 38-45, 47-53, and 67 are also in condition for allowance.

In relation to Claims 23, 28, 54, and 59, Feuerstraeter fails to teach an apparatus and a method for establishing a data transmission by "determining [a] number of transmission resources [that are] based on the bandwidth of the data transmission and a transmission convention," e.g., 694 of FIG. 37, and "[accessing] the number of transmission resources to transmit data to the target entity," e.g., 696 of FIG. 37.

Applicants have previously stated that Feuerstraeter is not shown to determine a number of transmission resources to be used for a data transmission based upon a bandwidth of the data transmission. Rather, Feuerstraeter is shown only to use a single transmission resource regardless of the bandwidth that is required. In particular, Feuerstraeter is shown to use either a 100Base network computer via a category 5 type cable (see column 6, lines 15-17), or a 10Base network computer via a category 3 type 3 cable (see column 6, lines 23-25), regardless of the bandwidth used. Thus, "determining a number of transmission resources based upon the bandwidth of the data transmission" seems to be completely absent from Feuerstraeter, since the number of transmission resources used by Feuerstraeter seems to be always be equal to one, regardless of the bandwidth required. Thus, Applicants respectfully submit that Claims 23, 28, 54, and 59 are in condition for allowance.

Dependent Claims 24-25, 29-30, 32, 55-56, 58, 60-61, and 62-63, which are dependent from independent Claims 23, 28, 54, and 59, respectively, are also

rejected under 35 U.S.C. §102(e) as being unpatentable over Feuerstraeter. While Applicants do not acquiesce to the particular rejections to these dependent claims, it is understood that these rejections are now moot in view of the remarks made in connection with independent Claims 23, 28, 54, and 59. These dependent claims include all of the limitations of the base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 24-25, 29-30, 32, 55-56, 58, 60-61, and 62-63 are also in condition for allowance.

Furthermore, the Office Action reiterates certain claim language in Claims 1, 2-3, and 7-8 of Feuerstraeter, as teaching elements of Claims 5-8, 11, 15-21, 23-25, 28-30, 32-33, 35-37, 39-42, 47-52, 54-55, 58, 60, 63, and 66-67 of the instant application. It is respectfully submitted that the claim language of Feuerstraeter as cited by the Office Action is not sufficiently clear to consider as to the alleged specific teaching.

The office action fails to establish that Claim 37 is anticipated under 35 U.S.C. 102(e) by U.S. Patent No. 6,266,701 to Sridhar et al (hereinafter "Sridhar").

The Office Action suggests that "a transmission convention is nothing more than a protocol." The Office Action further shows that "[a]ll the computers are coupled to Internet 100, which uses the Internet Protocol (IP) for network layer (ISO layer 3) communication. Client application 611 a server application 619, 621, 634 are configured to use TCP" is taught by Sridhar. (See column 8, lines 10-14). The Office Action admits, therefore, that the transmission protocol, which the Office Action suggests corresponds to the transmission convention of Applicant's Claim 37, between all client and server applications, as taught by Sridhar, is fixed to use TCP. Fixing the transmission convention to TCP, however, precludes the necessity to "[determine] transmission characteristics between the transmitting entity and the target entity," and to "[determine] a transmission convention based on the transmission characteristics," which is in contradistinction to Applicants' Claim 37. Accordingly, Applicants submit that Claim 37 patentably distinguishes over Sridhar and is in condition for allowance.

Furthermore, the Office Action identifies certain claim language in Claims 1, 5, and 11 of Sridhar, as teaching elements of Claim 37. It is respectfully submitted that

the claim language of Sridhar as cited by the Office Action is not sufficiently clear to consider as to the alleged specific teaching.

The office action fails to establish that Claims 9-10, 26, 31, 57, and 62 are unpatentable over Feuerstraeter in view of Computer Networks by Andrew S. Tanenbaum (hereinafter "Tanenbaum") under 35 U.S.C. 103(a).

To establish *prima facie* obviousness of a claimed invention, the Examiner has the burden of proving that three basic criteria are met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. All three of these criteria must be met in order to support a finding of *prima facie* obviousness of a claimed invention (See MPEP § 2142).

Concerning the third criteria which must be met to establish *prima facie* obviousness of a claimed invention, and as discussed above, Feuerstraeter has not been shown to teach or suggest the use of determined transmission characteristics of a transmission path between a transmitting entity and a target entity in order to select a transmission convention prior to data transmission, as is at least set forth in independent claim 1. Furthermore, as discussed above, Feuerstraeter is not shown to determine a number of transmission resources to be used for a data transmission based upon a bandwidth of the data transmission, as is at least set forth in independent Claims 23, 28, 54, and 59.

Since Claims 9-10, 26, 31, 57, and 62 depend upon independent Claims 1, 23, 28, 54, and 59, respectively, then Claims 9-10, 26, 31, 57, and 62 inherit all of the limitations as set forth in independent Claims 1, 23, 28, 54, and 59 as discussed above. Thus, Feuerstraeter is also deficient with respect to Claims 9-10, 26, 31, 57, and 62. The Office Action fails, however, to show how Tanenbaum remedies the deficiencies of Feuerstraeter with respect to Claims 9-10, 26, 31, 57, and 62. Applicants respectfully submit, therefore, that Claims 9-10, 26, 31, 57, and 62

patentably distinguish over the combination of Feuerstraeter with Tanenbaum and are in condition for allowance.

Notwithstanding the deficiencies of the combination of Feuerstraeter with Tanenbaum as discussed above, Applicants respectfully assert that other deficiencies relating to Feuerstraeter as tacitly acknowledged by the Office Action on page 24 do not constitute facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. Taking official notice of the above-discussed facts disregards the requirement of analyzing Applicant's claimed subject matter as a whole. Applicants respectfully reiterate the legal tenet that facts so noticed should not comprise the principle evidence upon which a rejection is based. MPEP § 2144.03. Thus, since Tanenbaum has not been shown to remedy the deficiencies of Feuerstraeter with regard to each element of the rejected dependent claims and each element of the corresponding independent claims, the rejection of Claims 9-10, 26, 31, 57, and 62 fails as to the third criteria, which must be met to support a finding of *prima facie* obviousness.

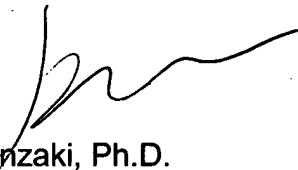
The office action fails to establish that Claims 34 and 65 are unpatentable over Feuerstraeter in view of U.S. Patent No. 6,618,360 to Scoville et al (hereinafter "Scoville") under 35 U.S.C. 103(a).

Concerning the third criteria which must be met to establish *prima facie* obviousness of a claimed invention, and as discussed above, Feuerstraeter has not been shown to teach or suggest the use of determined transmission characteristics of a transmission path between a transmitting entity and a target entity in order to select a transmission convention prior to data transmission, as is at least set forth in independent Claims 33 and 64. The Office Action fails to show, however, how the combination of Feuerstraeter with Scoville remedies this deficiency and thus fails to establish *prima facie* obviousness with respect to Claims 33 and 64. Furthermore, since Claims 34 and 65 include all of the limitations of Claims 33 and 64, respectively, and recite additional features which further distinguish these claims from the combination of Feuerstraeter with Scoville, Applicant respectfully submits that Claims 34 and 65 patentably distinguish over the combination of Feuerstraeter with Scoville and are in condition for allowance.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Amendments and Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

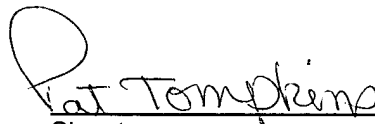
Respectfully submitted,



Kim Kanzaki, Ph.D.  
Attorney for Applicants  
Reg. No.: 37,652  
(408) 879-6149

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on May 8, 2006.

Pat Tompkins  
Name

  
Signature